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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,625	03/22/2001	Peter Gleichenhagen	tesa AG 719-KGB	6272
27384	7590	06/30/2004	EXAMINER	
KURT BRISCOE NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,625

Applicant(s)

GLEICHENHAGEN ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/10/04 & 04/08/04.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12-30 is/are rejected.
7) ☒ Claim(s) 13, 23 and 24 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/10/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 03/10/04 has been considered and scanned into the application file.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: As far as the Examiner can tell, no express support can be found for the following:

- (a) In claim 12 @ line 5, "size distribution in size ranges between 0.5 μm and 1000 μm ;
- (b) In claim 14 @ line 3, "vinyl C1-C3"
- (c) In claim 15 @ lines 3, 4 & 6, "in a concentration of up to 4 % by weight based on the total weight of the aqueous dispersion" & "water-soluble substances";
- (d) In claim 16 @ line 2, "water-soluble substances";
- (e) In claim 17 @ lines 3 & 4, "one or more polyacrylate chain-length-regulating substances present in amounts of up to 10 % by weight based on the weight of the polyacrylate";
- (f) In claim 18 @ line 3, "maleic esters";
- (g) In claim 19 @ lines 3 & 4, "water-insoluble initiators which are soluble in the monomers in amounts of up to 1 % by weight based on the weight of the monomers";
- (h) In claim 21 @ lines 2 & 3, "the polyacrylate is soluble without gel in an organic solvent and has a relative viscosity at 25 degrees C in toluene of 1680-5000 and a melting range between 80 degrees C and 170 degrees C";
- (i) In claim 23 @ lines 2-7, "wherein the concentrated aqueous dispersion is dewatered in a kneading device or extruder having a devolatilizing means operating at a temperature between 90-160 degrees C to form a the homogeneous, molecularly-disperse polyacrylate melt, or b) the homogeneous, molecularly-disperse polyacrylate

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melt is filmed to form a film by pressing the homogeneous, molecularly-disperse polyacrylate melt through a slot die by means of toothed wheel pumps and/or extruder screws”;

(j) In claim 24 @ lines 4-7, “one or more inorganic fillers are added to the concentrated aqueous dispersion in amounts up to 40 % by weight based on the polyacrylate and/or one or more polyacrylate-compatible plasticizers are added to the concentrated aqueous dispersion in amounts up to 30 % by weight based on the polyacrylate”;

(k) In claim 25 @ lines 2-3, “one or more tackifier resins are added to the concentrated aqueous dispersion in amounts up to 50 % by weight”;

(l) In claim 27 @ lines 4-7, “and/or one or more polyunsaturated (meth)acrylic monomers are incorporated into the polyacrylate by copolymerization in amounts up to 5 % by weight---to yield an insoluble of up to 95 % by weight acrylic polymer”;

Claim Objections

3. Claims 13, 23 & 24 are objected to because of the following informalities: In claim 13 @ line 2, “comprises” should read “comprise”, @ at line 3, “a total”(2nd occurrence) should read “the total” and @ line 4, “C4-C-12” should read “C4-C12”; In claim 13 @ lines 3, 5 & 7, it is suggested that “based on the total weight of monomers”, each occurrence, be deleted and “, based on the total weight of monomers,” be inserted in its stead; In claim 23 @ line 4, “a the” should read “the”; In claim 24 @ line 2, “dewatering.” should read “dewatering,”; Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 12-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "between 68-87 % by weight" per claim 12 constitutes indefinite subject matter as per it not being readily ascertainable as to how the "-" further limits "between". It is suggested that the "-" be replaced with the conjunctive "and", consistent with the qualifier "between".

B) The recited "size distribution in size" per claim 12 engenders redundant subject matter.

C) The recited "a total of" (first occurrence) per claim 13 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the claim.

D) The recited "acrylic polymer" per claim 27 constitutes indefinite subject matter as per it not being readily ascertainable as to how "acrylic polymer" further limits the antecedently recited "polyacrylate".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-21 and 28-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dunaway et al(U.S. 6,040,380), Dunaway et al(U.S. 6,228,935).

Each of Dunaway et al'380 and '935 teach processes for preparing a hot-melt pressure sensitive adhesive and products therefrom comprising polymerizing predominantly (at least 50 wt. %) of one or more acrylate and/or vinyl acetate monomers and optionally other comonomers such as acrylamide, styrene, multifunctional monomers, etc. in the presence of a seed latex, anionic emulsifiers, nonionic emulsifiers and combinations thereof, chain transfer agents and other conventional additives which yields a high solids(70 to 95 weight %) bimodal polymer particle dispersion governed by a particle size of around 0.5 to 100 microns(concentrated aqueous dispersion). Each of Dunaway et al'380 and '935 further teach that other conventional additives can be added to the polymer dispersions, which include fillers, plasticizers, U. V. stabilizers, crosslinking agents, diluents and tackifiers. Each of Dunaway et al therefore anticipate the instantly claimed invention with the understanding that the pressure-sensitive adhesive preparatory process per each of Dunaway et al'380 and '935 overlaps in scope with the claimed pressure-sensitive adhesive preparatory process. See, the Abstract, col. 1, lines 14-25, col. 2, lines 6-23 and 35-67, col. 3, lines 1-29, col. 4, lines 18-67, cols. 5-9, the Runs and claims of Dunaway et al'380 and the Abstract, col. 1, lines 15-28, col. 2, lines 10-67, col. 3, lines 1-32, col. 4, lines 21-67, cols. 5-9, the Runs and claims of Dunaway et al'935.

As to the "gel-free, molecularly-dispersed" and "meltable" properties, as claimed, it would be expected that these properties are met by the acrylate polymer

particles of each of Dunaway et al'380 and Dunaway et al'935 since the acrylate polymer dispersions of each of patentees are essentially the same as and made under essentially the same conditions as the claimed polyacrylate dispersion. It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

Even if this turns out not to be the case and the claimed invention is not anticipated, it would have been obvious to the skilled artisan to extrapolate, from the disclosures of each of Dunaway et al'380 and Dunaway'935, the precisely defined process and product therefrom as per such having been within the purview of the general disclosures of patentees and with a reasonable expectation of success.

As to the dependent claims, the limitations are either taught by patentees, suggested by patentees or would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunaway et al(6,040,380) or Dunaway et al(U.S. 6,228,935) in combination with LaRose et al(U.S. 5,716,669).

Each of Dunaway et al'380 and Dunaway et al'935 are relied on for what is taught as stated in the rejection supra per paragraph no. 8 as applied to claims 12-21 and 28-30. Further, the disclosure of each of Dunaway et al differ basically from the claimed invention as per the non-specific disclosure of an embodiment directed to the specific steps as defined per claims 22-27. However, processes for producing pressure sensitive adhesives derived from concentrated aqueous

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dispersions of acrylic-based polymers using conventional dewatering processes, as claimed, are known per LaRose et al(see the Abstract and cols. 1-6 of LaRose et al). Therefore, it would have been obvious to the skilled artisan to subject the concentrated aqueous acrylate polymer dispersion of each of Dunaway et al to the conventional dewatering techniques of LaRose and with a reasonable expectation of success.

Response to Arguments

13. Applicant's arguments filed 03/10/04 & 04/08/04 have been fully considered but they are not persuasive.

Relative to the 112, 2nd paragraph issues----While Counsel, in a good faith effort, attempted to remedy the 112, 2nd paragraph issues raised in the previous Office Action(12/04/03), new 112, 2nd paragraph issues were created and are as set forth supra.

The indication of allowability of claims 12-30 in the previous Office Action(paper no. 13, 12/04/03) is regrettably herein rescinded. An apology is extended to Counsel for any inconvenience that this may have caused.

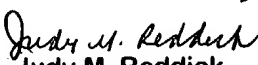
Conclusion

14. The prior art to Gerst et al(U.S. 6,423,769), listed on the attached FORM PTO 892 is cited as of interest in teaching pressure sensitive adhesives derived from concentrated acrylate polymer dispersions. A rejection in the future may be made based on this prior art. However, since a valid rejection exists on the record, a rejection at this time is not being made. The remainder of the prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
06/27/04